



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/073,216

02/13/2002

Tarja Pirttimaa

047092.00137

4809

32294

7590

04/15/2008

SQUIRE, SANDERS & DEMPSEY L.L.P.

8000 TOWERS CRESCENT DRIVE

14TH FLOOR

VIENNA, VA 22182-2700

EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT

PAPER NUMBER

2136

MAIL DATE

DELIVERY MODE

04/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/073,216	Applicant(s) PIRTTIMAA ET AL.	
	Examiner PRAMILA PARTHASARATHY	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/26/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 2,9 and 22-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-21,29-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the communication 12/26/2007. In response to the previous office action, Applicant has cancelled Claims 2, 9, 22 – 28 and has amended Claim 13. Claims 1, 3 – 8, 10 – 21 and 29 – 36 are currently pending.

Response to Arguments

2. Applicant's arguments filed 12/26/2007, with respect to the rejection(s) of claim(s) 1 – 36 have been fully considered.

Applicant's arguments with respect to 35 USC 112, First paragraph rejections and Second paragraph rejections are persuasive. Therefore, the rejections have been withdrawn.

Applicant's arguments with respect to Double patenting rejections are not found persuasive. Applicant's argue that the office action does not include an analysis of "how the applications could have been filed together or how the claims of the '676 patent are obvious in view of the claims of the present application as well as how the claims of the present application are obvious in view of '676 patent". Examiner believes such comparison of claims have already shown clearly in previous office actions, however, Examiner hereby expands the comparison and reasoning for comprehensibility while maintaining the same grounds of rejection of the claims.

Instant application relates to a method for providing secure access by initiating a protection processing for messages received from a terminal device. Details of the method are disclosed in paragraph [0039 - 0048], wherein, Initially, a setup procedure for setting up a security association, SIP request message, e.g., INVITE message sent from UE1 to the P-CSCF to perform an address comparison for a subscribed user and forwarding a decision to S-CSCF are supported in the Patent 6,788,676 in Column 6 line 34 - Column 7 line 28, and IMPU registration and IMPI authentication of instant

Art Unit: 2136

disclosure (paragraph [0040]) finds support in the Patent 6,788,676 in Column 10 line 61 – Column 11 line 50 along with Scope of the Invention (column 12 line 51 – Column 13 line 7), thus establishing the fact that both inventions could have been filed together.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 3 – 8, 10 – 21 and 29 – 36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 14 of U.S. Patent No. 6,788,676. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1, 3 – 8, 10 – 21 and 29 – 36 correspond to the claims of 1 – 14 of the patent claims, except in the instant claims the element, “comparing said first and second source information and dropping message if comparing first source and second source information do not indicate the same location” is referred in the patent claims as “the IMS (IP multimedia subsystem) is able to route subsequent SIP signaling (message) through the IMS proxy

Art Unit: 2136

(P). It would have been obvious to one having ordinary skill in the art to recognize that providing packet filtering by comparing the first and second source information is equivalent to having an IMS proxy server routing the messages that are registered with the proxy through P-CSCF filtering". ""'. Patent claims recite, "A method ...requests for internet protocol communications across a packet switched communication network" and "wherein the predetermined protocol is session initiation protocol" which encompasses the instant application claims, "A method comprising receiving a message from a terminal device connected to a packet data network" and "wherein said message is a session initiation protocol message". Thus patent claims anticipate the instant claims.

Claims of the instant application are anticipated by patent claims in that the patent claims contains all the limitations of the instant application. Claims of the instant application therefore is not patentably distinct from the earlier patent claims and as such are unpatentable for obvious-type double patenting (*In re Goodman (CAFC) 29 USPQ2d 2010 (12/3/1993)*)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2136

4. Claims 1, 3 – 8, 10 – 21 and 29 – 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Kennedy et al. (US Publication 2004/0252683).

5. As per Claims 1, 13 and 36 Kennedy teaches “receiving a message from a terminal device connected to a packet data network; deriving a first source information from said message; deriving a second source information; comparing said first and second source information; initiating a protection processing based on the result of said comparing; and providing secure access to said packet data network based on said protection processing (paragraph [0062 – 0067].

6. Claims 3, 6 – 8, 10, 12, 14 – 15, 19 – 21, 29 – 35, are rejected by the virtue of their dependency on rejected parent claims and further more, Kennedy teaches "protection process", "first and second source information is an Internet protocol address", "session initiation protocol message" and “proxy call/server” (paragraph [0062 – 0067]).

Allowable Subject Matter

7. Claims 4, 5, 11, 16, 17, 18, 30, 31, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Nasser Moazzami can be reached on 571-232-4195. Any inquiry of a

Art Unit: 2136

general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Pramila Parthasarathy/
Examiner, Art Unit 2136
April 13, 2008